

Applicant : Murakami et al.  
Serial No. : 09/349,049  
Filed : July 7, 1999  
Page : 9 of 14

Attorney's Docket No.: 16709-009001 / F690US

### REMARKS

Claims 1-35 are pending, with claims 1, 5, and 20 being independent. Claims 1, 5, 13, 14, 20, 29, and 30 have been amended and claims 10, 12, 15, 26, 28, and 31 have been cancelled. No new matter has been added. Applicants respectfully ask that all claims be allowed in view of the amendments and following remarks.

#### **Rejection Under 35 U.S.C. 103: Tagami and DeLorme**

Claims 1, 4-5, 9-21 and 25-35 are rejected as allegedly being unpatentable over Tagami et al. (U.S. Patent No. 5,812,070; hereinafter "Tagami") in view of DeLorme et al. (U.S. Patent 5,948,040; hereinafter "DeLorme"). This rejection is respectfully traversed.

#### **Tagami**

Tagami teaches a shared vehicle system where a plurality of motor vehicles is supervised by a control center (see Abstract). That control center is in communication with a main parking port, which includes a computer that selects vehicles for users (see col. 4, lines 31-34; col. 5, lines 33-36). The computer selects available motor vehicles according to reservation principles and a registration group corresponding to a user (see col. 1, lines 52-59; col. 2, lines 4-12). In order to do so, the computer selects vehicles based on a usage time zone of users that depends on the past usage of users (see Abstract; col. 5, lines 6-11; col. 8, lines 27-28). One of the advantages of such a system is that a user can rent a motor vehicle with minimal input, i.e. by merely using an IC card identifying the user (see generally col. 1, line 27 through col. 2, line 23).

#### **DeLorme**

DeLorme teaches a travel reservation and planning system that is typically implemented in software running on a personal computer (see col. 14, lines 53-65). The system receives inputs relating to times and destinations for a trip and generates, for example, a printed output including an itinerary and a series of reservations (col. 8, line 49 through col. 9, line 2; col. 13, lines 31-46).

Applicant : Murakami et al.  
Serial No. : 09/349,049  
Filed : July 7, 1999  
Page : 10 of 14

Attorney's Docket No.: 16709-009001 / F690US

### The Present Application

As amended, the claimed subject matter is directed towards a vehicle sharing system including a control center and at least one port with one or more parking spaces for vehicles (see, e.g. claim 1). In one aspect, the control center receives an input relating to a time duration of an intended trip and based on that time duration, and perhaps other information such as distance of the intended trip or a destination port, the control center selects a vehicle and/or allocates a vehicle to a user (see e.g. claims 1 and 5).

### Traversal

The following criteria are required to establish a prima facie case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the combined prior art references must teach or suggest all the claim limitations (see MPEP 706.02(j)). These criteria have not been met. The present application is patentable over Tagami in view of DeLorme because (A) there is no motivation to combine Tagami and DeLorme as there is no motivation in either the prior art or in the knowledge of one of ordinary skill; (B) Tagami teaches away from the combination of Tagami and DeLorme thus the combination is improper; and (C) because certain features of the present application are not present in either Tagami or DeLorme.

#### (A) No Motivation to Combine

As discussed earlier and, in part, in the recent Official Action, Tagami teaches receiving input including past usage history and allocating a vehicle based on the past usage history, which, unlike the claimed subject matter of the present application, does not teach receiving information related to an intended trip, such as an estimated distance and time duration, and selecting and/or allocating a vehicle based on that criteria (Official Action mailed Feb. 27, 2002, see e.g. page 3, para. 1; page 4, para. 2. See generally claims 1, 5, and 20). However, DeLorme does disclose, for example, a personal computer receiving information indicating a travel time duration.

Applicant : Murakami et al.  
Serial No. : 09/349,049  
Filed : July 7, 1999  
Page : 11 of 14

Attorney's Docket No.: 16709-009001 / F690US

There is no motivation to combine Tagami and DeLorme. Neither reference includes a motivation to combine a vehicle sharing system that allocates vehicles based on past usage history with a travel planning system that generates printed itineraries and reservation information. Nor is there a motivation that was known to one skilled in the art at the time the application was filed. The Official Action states:

it would have been obvious to a person having ordinary skill in the art at the time the invention was made to include the user's inputted departure point, finish point and time frame regarding an intended trip in the Travel Reservation and Information System (TRIPS) as taught by DeLorme et al. within the vehicle sharing system as taught by Tagami et al. with the motivation of enabling the users to revise or edit travel plans and alternate routes (see: DeLorme et al. abstract). Such a modification would ensure the proper vehicle having the necessary requirements are allocated to user, within the combined system (emphasis added).

This motivation is insufficient because, at least, the combination of Tagami and DeLorme does not follow from the motivation of enabling users to revise travel plans and because the asserted statements would not have been of knowledge to one of ordinary skill in the art.

First, the combination does not follow from the motivation asserted because the motivation of enabling users to revise travel plans would not motivate one of ordinary skill in the art to combine a vehicle sharing system based on past usage history with the receipt of travel plans. Tagami does not mention or suggest receiving travel plans as input or allocating vehicles based on travel plans. In fact, Tagami teaches receiving information corresponding to a user's registration information and allocating vehicles based on past usage history, which freely allows users to rent a vehicle without having to make a reservation or travel plans (see col. 1, line 28 through col. 2, line 23). Thus, it does not follow that Tagami would want to enable users to edit any travel plans or alternative routes as the users never had any travel plans in the first place, and the system of Tagami would not use that information to allocate vehicles.

Second, Applicants disagree that parts of the motivation to combine asserted in the Official Action were common knowledge to one of ordinary skill in the art. MPEP 2144.03 provides the procedure for relying on common knowledge in a rejection ( a.k.a. taking official

Applicant : Murakami et al.  
Serial No. : 09/349,049  
Filed : July 7, 1999  
Page : 12 of 14

Attorney's Docket No.: 16709-009001 / F690US

notice). In accordance with that procedure, taking official notice should be judiciously performed in limited circumstances. In fact, if a final action were to be supported by official notice, the circumstances should be "rare," the knowledge should be "capable of such instant and unquestionable demonstration as to defy dispute," and "[i]t [would] never [be] appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection [is] based." Also, in accordance with those procedures, "if Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence (MPEP 2144.03.C.) (case changed)."

As understood, part of the motivation asserted in the Official Action includes ensuring that a vehicle having the necessary requirements are allocated to a user based travel information related to an intended trip. Applicants disagree that this would have been common knowledge to one of ordinary skill in the art.

#### **(B) Tagami Teaches Away from the Combination**

Tagami teaches away from the combination of Tagami and DeLorme, thus the combination is improper. Tagami teaches away from the combination because, in part, the advantages and techniques taught by Tagami teach away from this combination. As discussed earlier, Tagami teaches a vehicle sharing system where vehicles are allocated based on registered groups and/or past usage history. By allocating vehicles based on past usage history, without a user entering input related to an intended trip, Tagami benefits users because users enter a minimal amount of data and analysis can be performed on past usage histories to generate what Tagami views as an optimal allocation of vehicles (col. 7, line 62 through col. 8, line 34). By contrast, DeLorme involves the input of travel information for a trip that is being planned. Tagami teaches away from the combination with DeLorme because users would not benefit from the method of renting a vehicle in Tagami if users were to input travel information. Further, the analysis applied to past usage history in Tagami teaches away from inputting travel information for a trip that is being planned. Thus, the combination of Tagami and DeLorme is improper.

Applicant : Murakami et al.  
Serial No. : 09/349,049  
Filed : July 7, 1999  
Page : 13 of 14

Attorney's Docket No.: 16709-009001 / F690US

**(C) Features of Present Application are not Present in the Prior Art**

Neither Tagami nor DeLorme teach or suggest features of the claimed subject matter, as amended; thus, the claimed subject matter cannot be unpatentable over Tagami in view of DeLorme. As discussed earlier, the independent claims of the present application include features of receiving travel information related to an intended trip, such as time duration, an estimated distance, and/or a destination port, and selecting and/or allocating a vehicle based on that travel information. For example, consider portions of independent claim 1:

a control center including a computer unit for processing said request and  
allocating a vehicle based on an estimated distance and time duration of an intended trip  
indicated in said request (emphasis added).

Neither Tagami nor DeLorme teach or suggest receiving user input related to an intended trip; receiving an estimated distance and time duration of an intended trip; receiving a desired time duration of an intended trip; selecting and/or allocating a vehicle based on travel information of an intended trip; selecting and/or allocating a vehicle based on an estimated distance and time duration; or, selecting and/or allocating a vehicle based on a destination port and a desired time duration (see independent claims 1, 5, and 20).

For all of these reasons Applicants suggest that claims 1, 5, and 20 are allowable. Additionally claims 4-5 and 9; 11 and 13, 14, 16-19; and, 21, 25, 27, and 29-35, are dependent upon independent claims 1, 5, and 20, respectively, thus these claims should also be allowable.

**Rejection Under 35 U.S.C. 103: Tagami and Klein**

Claims 2-3, 6-8 and 22-24 are rejected as allegedly being unpatentable over Tagami in view of Klein et al. (U.S. Patent No. 5,726,885; hereinafter "Klein"). This rejection is respectfully traversed. Because claims 2-3, 6-8 and 22-24 depend on independent claims 1, 5, and 20, respectively, these claims should also be allowable.

**Summary**

The claims have been amended to clarify that vehicles are selected and/or allocated based on information related to an intended trip, such as a destination port, an estimated distance,

Applicant : Murakami et al.  
Serial No. : 09/349,049  
Filed : July 7, 1999  
Page : 14 of 14

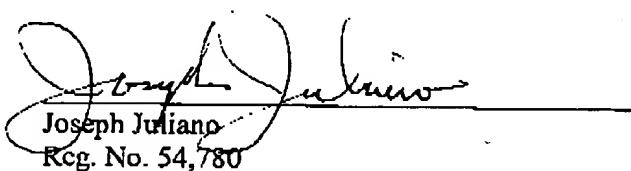
Attorney's Docket No.: 16709-009001 / F690US

and/or a desired time duration. The combination of Tagami and DeLorme should be withdrawn. Moreover, features of the independent claims do not appear in the prior art nor were they known to one of ordinary skill. In view of the above amendments and remarks, therefore, all of the claims should be in condition for allowance. A formal notice to that effect is respectfully requested.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 4/21/2004



Joseph Juliano  
Reg. No. 54,780

PTO Customer No. 20985  
Fish & Richardson P.C.  
12390 El Camino Real  
San Diego, California 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

10386396.doc